

## REMARKS

Upon entry of the present amendment, claims 3, 18-19, 21-22, 25-26, and 28 are pending in the application.

Claims 12-13 and 29-32 are withdrawn.

No claims have been amended, added or canceled.

Reconsideration is respectfully requested in view of the following remarks.

1. **Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,403,701 to Reusmann et al., hereafter "Reusmann", in view of EP 0 081 994 to Kawakami et al., hereafter "Kawakami".**

Applicant respectfully asserts that the present claims are patentable over Reusmann in view of Kawakami because the combination of the foregoing does not provide for a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

At the very least, Reusmann does not teach or suggest independent claim 3's component (A2), which is an aqueous color-imparting base color. This is consistently affirmed by the Examiner by stating that:

"The difference between the present claims and Reusmann invention is that Reusmann does not disclose a (A-2) component of an aqueous coating composition comprising a color-imparting pigment, binder and water."

(9/24/2007 Office Action, page 5, final paragraph).

The foregoing is further affirmed by the Examiner in the Advisory Action of 1/14/2008. (1/14/2008 Advisory Action, page 2).

The Examiner relies on Kawakami to remedy this deficiency. However, Applicant respectfully asserts that there is no suggestion or motivation for the combination of Kawakami with Reusmann, nor is there a reasonable expectation of success. In fact, such a combination would be improper for at least the following reasons.

Firstly, Applicant respectfully asserts that Reusmann teaches away from combining it with Kawakami.

Reusmann is directed to coating compositions having improved condensation resistance. (Reusmann, column 1, line 8-10). For the transition from conventional to water-thinnable systems, therefore, it is not sufficient simply to exchange the binders used for water thinnable binders. (Reusmann, column 1, lines 54-57). In recent times, the requirements for water and moisture resistance, especially for condensation resistance, of automotive refinishes have risen. (Reusmann, column 2, lines 35-37).

Therefore, Reusmann teaches that utilizing water-based coating compositions requires the binders to have improved condensation resistance. This improved condensation resistance is provided by Reusmann's binder only. Using any other water thinnable binder, such as that in Kawakami, would not be sufficient to meet the automotive OEM requirements for water and moisture resistance, and especially for condensation resistance.

Reusmann then discloses that it has surprisingly been found that the condensation resistance of finished coatings produced from the mixer systems of the general type described in DE-A4110520 can be increased considerably if the mixing component B) described therein has added to it as binder, a polymer which is obtainable by subjecting an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers to free-radical polymerization in the presence of a water-insoluble initiator and in an aqueous dispersion of a polyurethane resin which has a number-average

molecular weight of between 1000 and 30,000 Daltons and on average from 0.05 to 1.1 polymerizable double bonds, wherein the weight ratio between the polyurethane resin and the ethylenically unsaturated monomer or monomer mixture is between 1:10 and 10:1. (Reusmann, column 2, lines 43-58).

Therefore, Reusmann teaches that achieving improved condensation resistance in aqueous systems over the prior art can be effected by utilizing Reusmann's component (B), and only Reusmann's component (B). That is, a component comprising, as binder, a polymer which is obtainable by subjecting an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers to free-radical polymerization in the presence of a water-insoluble initiator and in an aqueous dispersion of a polyurethane resin which has a number-average molecular weight of between 1000 and 30,000 Daltons and on average from 0.05 to 1.1 polymerizable double bonds, wherein the weight ratio between the polyurethane resin and the ethylenically unsaturated monomer or monomer mixture is between 1:10 and 10:1.

Kawakami discloses a thermosetting resin prepared by mixing or reacting an alkylene diamine or polyalkylenepolyamine with an epihalohydrin, and a water-soluble resin obtained by reacting urea, a polyalkylenepolyamine, and a dibasic carboxylic acid and reacting the resultant polyamidopolyurea formaldehyde. (Kawakami, abstract). Kawakami's resin is thus substantially different from Reusmann's binder (B).

Therefore, Applicant respectfully asserts that there is no motivation to combine the above references because according to the teaching of Reusmann, one with ordinary skill in the art would be discouraged to use a binder other than Reusmann's binder (B) in aqueous compositions, expecting such a binder to give inferior results (no expectation of success), since it would not be as resistant to condensation as that of Reusmann. Kawakami's binder would be a "mere substitution of a conventional binder with a water miscible binder", which, as discussed above, is discouraged by Reusmann. Kawakami's binder would act to "dilute" the advantageous effects of using Reusmann's binder in an aqueous solution, and thus someone with ordinary skill in the art would not be motivated to do as such when Reusmann explicitly teaches that non-Reusmann type water thinnable

binders are inadequate for use in the disclosed applications since they will not provide the appropriate condensation resistance (see above).

Secondly, Applicant respectfully asserts that the Examiner, in arriving at this specific construction, has destroyed the intent of the references. In this regard, the courts have held that “[i]f the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The courts have also held that ‘[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.’” *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

As previously discussed, Reusmann is directed to a composition with improved condensation resistance, mainly because, as previously discussed, the aqueous composition comprises a specific binder (B). As previously discussed, the specific use of binder (B) with water produces the improved condensation resistance. Therefore, using Kawakami's binder with water would render Reusmann unsatisfactory for its intended purpose, since it would be expected to produce inferior condensation results because, as disclosed by Reusmann, the use of a non-Reusmann water thinnable binder in any amount would not provide appropriate resistance to condensation.

Therefore, Applicant respectfully asserts the combination of Kawakami with Reusmann is inappropriate because using Kawakami's binder would destroy the intended use of Reusmann, as discussed above.

In the Advisory Action of 1/14/2008, the Examiner states:

“The claimed (A-2) component is expected in Reusmann invention to control COATABILITY property. Reusmann does not disclose=does not name (A-2), since this component is expected. A worker in the art would add (A-2) to control=improve coatability property and control/correct color effect for an aqueous coating material. There is no claimed substrate, there is no

characteristic of the resulting coating material, there is no specified moisture resistance and condensation resistance (see remarks, page 9/13) in the present claims. Kawakami discloses an aqueous coating composition. To modify the aqueous coating composition in Reusmann invention by incorporating the composition of Kawakami in order to improve physical properties of coating composition is expected and the combination of teachings in cited references is proper. The rejection of record has not been withdrawn.”

*(1/14/2008 Advisory Action, page 2, emphasis in original).*

Therefore, it is understood that the Examiner is taking official notice that one with ordinary skill in the art would combine Kawakami's composition with Reusmann's composition in order to improve physical properties of the coating composition, such as the above cited coatability, color effect, moisture resistance, condensation resistance, and the like. The foregoing is understood because, as is previously discussed and will be discussed below, no documentary evidence is presented by the Examiner in support of this assertion, which is contrary to the teaching of the prior art of record.

Applicant respectfully traverses the Examiner's official notice at least on the ground that, in view of the teaching of Reusmann, one with ordinary skill in the art would in fact avoid combining Kawakami with Reusmann, and there would be no expectation of success in improving the physical properties of Reusmann's composition by combining it with Kawakami.

Reusmann teaches coating compositions having improved condensation resistance. (Reusmann, column 1, line 8-10). Reusmann explicitly teaches that for the transition from conventional to water-thinnable systems, therefore, it is not sufficient simply to exchange the binders used for water thinnable binders. (Reusmann, column 1, lines 54-57). In recent times, the requirements for water and moisture resistance, especially for condensation resistance, of automotive refinishes have risen. (Reusmann, column 2, lines 35-37). Reusmann then discloses that it has surprisingly been found that the condensation resistance of finished coatings produced from the mixer systems of the general type described in DE-A4110520 can be increased considerably if the mixing component B) described therein has added to it as binder, a polymer which is obtainable

by subjecting an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers to free-radical polymerization in the presence of a water-insoluble initiator and in an aqueous dispersion of a polyurethane resin which has a number-average molecular weight of between 1000 and 30,000 Daltons and on average from 0.05 to 1.1 polymerizable double bonds, wherein the weight ratio between the polyurethane resin and the ethylenically unsaturated monomer or monomer mixture is between 1:10 and 10:1. (Reusmann, column 2, lines 43-58).

Thus, Reusmann is concerned with improving condensation resistance in aqueous systems, and teaches that achieving this improved condensation resistance over the prior art can be effected by utilizing Reusmann's component (B). Reusmann conveys to one with ordinary skill in the art that a "mere substitution of a conventional binder with a water miscible binder", such as the combination of Kawakami, would act to "dilute" the advantageous effects of using Reusmann's binder in an aqueous solution, and would adversely affect the condensation resistance, which is of concern to Reusmann.

In essence, the combination of Kawakami with Reusmann would serve to destroy the intent of Reusmann. In this regard, the courts have held that "[i]f the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The courts have also held that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

Applicant respectfully asserts that the Examiner's official notice moot in view of the combination of Reusmann and Kawakami being improper, and also in view of the lack of suggestion, motivation, or expectation of success with regard to the properties of Reusmann being improved by combining it with Kawakami. The Examiner's allegation that such a combination would "improve physical properties of coating composition" is

unsupported and is contrary to Reusmann's teaching. (1/14/2008 Advisory Action, page 2).

As Applicant has shown, one with ordinary skill in the art would avoid the combination of Kawakami with Reusmann, concerned with how Kawakami would adversely affect Reusmann. The Examiner's official notice is thus moot, being unsupported by documentary evidence, while the prior art of record teaches otherwise. In this regard, the MPEP teaches that [i]f applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). MPEP 2144.03 (C).

In view of the above, Applicant respectfully asserts that the prior art references do not teach or suggest all the limitations of independent claim 3, and consequently those of dependent claims 18-19, 21-22, 25-26, and 28. Further, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine their teachings, and there is no reasonable expectation of success in doing so. Therefore, a prima facie case of obviousness has not been established, and the present claims are patentable over the cited references. Withdrawal of this rejection is respectfully requested.

In addition, Applicant respectfully submits that the Examiner has consistently held that:

"[...] appellants do not traverse the Examiner's position that the aqueous coating composition in Reusmann invention comprises a plurality of base colors (A) comprising color-effect pigment and coloring pigment, organic solvent and binder; and a pigment-free component (B) comprising a binder and water wherein a binder can be the same binder. Also, appellants do not argue that the amount of binder, water, solvent and solid content of pigments can

be varied depending on the intended use of the aqueous coating composition.”

*(9/24/2007 Office Action, paragraph bridging pages 6 and 7, in addition to previous communications).*

Applicant respectfully notes that the above statement by the Examiner is not what the Applicant is claiming. Applicant's claim 3 is directed to a process for preparing an aqueous coating material with precisely defined shade and optical effect as set forth in independent claim 3, on pages 2-4 above. Applicant respectfully submits that there is no requirement to traverse the Examiner's specific statements, which are construed as specific portions of a rejection, and are not the entirety of independent claim 3, that is, they are not the rejection as a whole. Applicant has consistently traversed the rejection under 35 U.S.C. 103(a) over Reusmann in view of Kawakami, and continues to do as such. Therefore, it would be inappropriate for the Examiner to question whether or not specific portions of a rejection are traversed, when the entire rejection is being traversed as not being prima facie obvious.

The courts have consistently held that “[t]he legal determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made.” *In re O'Farrell*, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). “Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making” the necessary modification. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051 5 U.S.P.Q.2d 1434, 1438 (Fed Cir.), *cert denied*, 488 U.S. 825 (1988).

Therefore, Applicant respectfully asserts that since the above rejection as a whole is being traversed, the Examiner's concern regarding whether or not specific portions of the rejection are being traversed is moot.



### CONCLUSION

Applicant respectfully submits that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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